

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	Steve Grove	Examiner:	David E. England
Serial No.:	09/976,301	Group Art Unit:	2143
Filed:	October 11, 2001	Docket No.:	2043.053US1
Title:	SYSTEM AND METHOD TO FACILITATE TRANSLATION OF COMMUNICATIONS BETWEEN ENTITIES OVER A NETWORK		

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Applicants request review of the final rejection in the above-identified application in Final Office Action mailed March 17, 2008. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated below:

*§103 Rejection of the Claims*

Claims 1, 4-5, 9-12, 15-16, 20-23, 26-27, 31-34, 37-38 and 42-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Flanagan et al. (U.S. Patent No. 5,966,685; hereinafter “Flanagan”) in view of Gastaldo et al. (U.S. Patent No. 6,473,729; hereinafter “Gastaldo”). Applicant respectfully traverses these rejections.

Please see “Amendment & Response Under 37 C.F.R. 1.116” mailed on May 19, 2008 for a statement of the law in rejecting claims under U.S.C. § 103(a).

The Final Office Action rejects independent claims 12, 23 and 34 on grounds similar to the grounds for rejection of independent claim 1. Accordingly, Applicant believes that patentability of independent claims 1, 12, 23 and 34 over Flanagan in view of Gastaldo is best understood with respect to independent claim 1.

**THE FINAL OFFICE ACTION DID NOT EXPLAIN WHY THE DIFFERENCES BETWEEN THE PRIOR ART AND THE CLAIMED INVENTION WOULD HAVE BEEN OBVIOUS TO ONE OF ORDINARY SKILL.**

The Final Office Action admits that Flanagan does not teach “*communicating a plurality of predetermined language constructs to a first entity as a first transmission over said network*” as recited by independent claim 1. To cure this deficiency, the Final Office Action contends that

Gastaldo teaches the feature in Figures 5 – 7 and the supporting text<sup>1</sup>. Independent claim 1 (as amended) includes the following limitations:

*communicating a plurality of **predetermined language** constructs to a first entity as a first transmission over said network; ...*

*...said **translated language construct is generated and stored, and said correspondence to said selected language construct is defined, prior to communication** of said plurality of language constructs to said first entity as said first transmission.*

Gastaldo is related to assisting a translator in getting appropriate translation for any phrase<sup>2</sup>. To achieve this goal, Gastaldo, apparently establishes a database of corresponding text fragments in different languages by aligning text fragments in the source and target manually translated documents. Gastaldo inputs a first document containing a text written in the first language; inputs a second document containing said text written in the second language; aligns corresponding text fragments of the first and second documents; extracts word phrases from the text fragments of the first document; and generates index information on the extracted word phrases and the **aligns text fragments** holding the word phrases.<sup>3</sup> In addition, the Final Office Action alleges that Flanagan teaches “*said translated language construct is generated and stored, and said correspondence to said selected language construct is defined, **prior to communications of said plurality of language constructs to said first entity as said first transmissions***”<sup>4</sup>.

Applicant respectfully disagrees. Flanagan relates messages that are posted to a discussion group, periodically collected, translated to other languages, and posted to target language discussion groups. The messages that are collected are sent to an automatic Machine Translation (MT) software for translation<sup>5</sup>. Accordingly, Flanagan relates a translation that occurs after the messages are posted. In contrast, claim 1 requires a translated language construct and a correspondence to a language construct that is defined prior to communication of the language construct to the first entity. Clearly, these systems operate in ways that are

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<sup>1</sup> The Final Office Action, Page 3

<sup>2</sup> Gastaldo, column 1, line 7

<sup>3</sup> Gastaldo, column 2, lines 49 – 58

<sup>4</sup> The Final Office Action, Page 5

<sup>5</sup> Flanagan, column 2, lines 35 – 43

fundamentally different. Even when combined Flanagan and Gastaldo may not be said to suggest to one of ordinary skill in the art the above quoted limitations of claim 1 or provide a basis for inferring the above quoted limitations of claim 1. Moreover, it is unclear what rational underpinning could possibly support the legal conclusion of obviousness in reaching the limitations of claim 1. Specifically, the MPEP states that Office personnel *must explain why the difference(s) between the prior art and the claimed invention would have been obvious* (emphasis added) to one of ordinary skill in the art. MPEP § 2141. Applicant respectfully points out that no such explanation is provided in the Final Office Action. Indeed, the Final Office Action is silent with respect to why the differences between the combination of Flanagan and Gastaldo and the claimed invention would have been obvious to one of ordinary skill in the art at the time of invention. Applicant respectfully submits that the Final Office Action has failed to establish a *prima facie* case of obviousness.

#### **COMBINING FLANAGAN AND GASTALDO DESTROYS THE STATED PURPOSE OF FLANAGAN**

According to the Final Office Action, it would be obvious to one of ordinary skill in the art, at the time the invention was made, to combine Gastaldo with Flanagan. The Final Office Action reasons that utilizing predetermined phrases in a database situation could aid in a faster translation since no real “translation” is occurring<sup>6</sup>. Combining Flanagan with Gastaldo by altering Flanagan to include predetermined phrases in a database situation, as suggested by the Final Office Action, would destroy the stated purpose of Flanagan. According to Flanagan, its purpose is to assist electronic discussion group users by utilizing existing translation software. According to Flanagan, messages posted to a discussion group will be periodically collected, translated to other languages, and then posted to those respective target language discussion groups. The new messages that are collected on a periodic basis are sent to commercially available automatic Machine Translation (MT) software for translation<sup>7</sup>. Thus, Flanagan requires utilization of third party automatic translation in order to synchronize multilingual forums. Furthermore, Flanagan is intended for forum users only familiar with their native

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<sup>6</sup> The Final Office Action, page 4

<sup>7</sup> Flanagan, column 2, lines 35 – 43

language.<sup>8</sup> Gastaldo, on the other hand, is related to assisting in translating documents and requires manual input from translators skilled in more than one language. Requiring forum users of Flanagan to select language structures of an unfamiliar language would destroy its purpose of facilitating communications with respect to multi-language forums. Accordingly, Applicant respectfully requests that the obviousness rejection of claim 1 be withdrawn. Please see “Amendment & Response Under 37 C.F.R. 1.116” mailed on May 19, 2008 that identifies other claims for which the above remarks are relevant.

Claims 2, 6-7, 13, 17-18, 24, 28-29, 35, 39-40 and 46-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Flanagan in view of Gastaldo, and further in view of Scanlan (U.S. Patent No. 6,857,022). Applicant respectfully submits that the rejection of claims 2, 6-7, 13, 17-18, 24, 28-29, 35, 39-40 and 46-48 under 35 U.S.C. § 103 is defective for the reason that a person of ordinary skill in the relevant field in determining the scope and content of the cited documents and understanding the differences between the cited documents and the independent claims of the present application would not conclude the independent claims are obvious.

Applicant submits that Flanagan and Gastaldo fail to disclose or suggest elements of claims 1, 12, 23 and 34 from which claims 2, 6-7, 13, 17-18, 24, 28-29, 35, 39-40 and 46-48 depend. Indeed, the Final Office Action alleges that Scanlan discloses elements peculiar to claims 2, 6-7, 13, 17-18, 24, 28-29, 35, 39-40 and 46-48 but is silent as to why Flanagan, Gastaldo, and Scanlan when combined would teach or suggest elements not disclosed by the combination of Flanagan and Gastaldo. Moreover, the Final Office Action has failed to explain why the differences between the combination of Flanagan, Gastaldo, and Scanlan and the rejected claims would render the rejected claims obvious to one of ordinary skill in the art. For the above reasons Applicant respectfully requests that the obviousness rejection of claims 2, 6-7, 13, 17-18, 24, 28-29, 35, 39-40 and 46-48 be withdrawn.

Claims 8, 19, 30 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Flanagan in view of Gastaldo, and further in view of Christy (U.S. Patent No. 6,301,554). Applicant respectfully submits that the rejection of claims 8, 19, 30 and 41 under 35 U.S.C. § 103 is defective for the reason that a person of ordinary skill in the relevant field in determining

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<sup>8</sup> Flanagan, column 1, line 57

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the scope and content of the cited documents and understanding the differences between the cited documents and the independent claims of the present application would not conclude the independent claims are obvious. Moreover, the Final Office Action has failed to explain why the differences between the combination of Flanagan, Gastaldo, and Christy and the rejected claims would render the rejected claims obvious to one of ordinary skill in the art. For the above reasons Applicant respectfully requests that the obviousness rejection of claims 8, 19, 30 and 41 be withdrawn.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 408-278-4051 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date June 16, 2008

By Mark R. Vatuone  
Mark R. Vatuone  
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16 day of June, 2008.

**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this

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